

REMARKS

Claims 78, 84 and 90 are canceled without prejudice, and therefore claims 13, 15, 17, 37, 39, 41, 59, 61, 63, 79 to 83, 85 to 89 and 91 to 95 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

Applicants thank the Examiner for accepting the Drawings.

With respect to paragraphs 30, 31, and 32, Applicants thank the Examiner for indicating that claims 81 to 83, 87 to 89 and 93 to 95 contain allowable subject matter. While the rejections of the base claims may not be agreed with, to facilitate matters, the claims 81, 87, and 93 have been rewritten as appropriate. Accordingly, all of claims 81 to 83, 87 to 89 and 93 to 95 are allowable, and it is therefore respectfully requested that the objections be withdrawn.

With respect to paragraph three (3) of the Office Action, claims 13, 15, 17, 37, 39, 41, 59, 61 and 63 were rejected for double patenting under 35 U.S.C. 101 as to claims 13-16, 26-30 and 38-41 of U.S. Patent No. 6,768,488.

While the double-patenting assertion may not be agreed with since the Office Action compares the claims of the application with the features described in the dependent claims of U.S. Patent No. 6,768,488, to facilitate matters, claims 13, 37 and 59 have been rewritten to include the features of claims 78, 84 and 90, which have been canceled without prejudice. Also, claims 79, 85 and 91 have been rewritten to depend respectively from claims 13, 37 and 59, since claims 78, 84 and 90 have been canceled without prejudice, since their features have been included in claims 13, 37 and 59, as presented. It is therefore respectfully requested that the Section 101 double-patenting rejections be withdrawn.

With respect to paragraph fifteen (15) of the Office Action, claims 13, 15, 17, 37, 39, 41, 59, 61 and 63 were rejected under 35 U.S.C. § 103(a) as obvious over Hayashi, U.S. Patent No. 5,611,037, in view of Nomura et al., U.S. Patent No. 5,877,772.

While the rejections may not be agreed with, to facilitate matters, claims 13, 37 and 59 have been rewritten.

As explained in the parent application,, Hayashi does not identically describe the step of “filling colored line”, as provided for in the context of claim 13, as presented. According to claim 13 as presented, when a pointing device is in a first state and boundary line information of coordinates at the pointing device represents a region other than the boundary

line, color information of the coordinates is obtained, and when the pointing device represents the boundary line, the obtained color information is provided to the coordinates at the pointing device. Therefore, as described in page 43 in the specification with respect to the exemplary embodiment, for example, when the user pushes the mouse button at a brighter color region of regions divided by the colored line, and moves the mouse pointer on a part of the colored line where the user wants to change the color, the color of the part where the mouse pointer passed through can be changed to the brighter color, as shown, for example, in Figure 50.

Also, claim 13 has been rewritten to include the features of claim 78, which has been canceled without prejudice. This “claim 78” feature is not disclosed nor suggested by the Hayashi or Nomura references (nor by the Windows 95 Paint Program, as explained below; this reference may refer to painting a boundary line with a brush, but it does not disclose nor suggest changing a color of only the colored line when the pointing device is moved from a region to another region across the colored line).

It is respectfully submitted that the secondary “Nomura” reference does not cure the foregoing critical deficiencies of the primary “Hayashi” reference.

Accordingly, claim 13 as presented is allowable for the foregoing reasons, as are its respective dependent claims.

Claims 37 and 59 have been rewritten like claim 13 to include the like features of claims 84 and 90, respectively. Claims 84 and 90 have been canceled without prejudice. Accordingly, claims 37 and 59 are allowable for essentially the same reasons as claim 13, as presented, as are their respective dependent claims.

Accordingly, claims 13, 15, 17, 37, 39, 41, 59, 61 and 63 are allowable.

With respect to paragraph twenty-two (22), claims 78 to 80 were rejected under 35 U.S.C. § 103(a) as obvious over Hayashi, U.S. Patent No. 5,611,037, in view of Nomura et al., U.S. Patent No. 5,877,772, and further in view of the Windows 95 Paint Program.

As explained above, claim 78 has been canceled since its features have been included in claim 13 as presented, and claim 79 now depends from claim 13, as does claim 80.

The “claim 78” feature is not disclosed nor suggested by the Hayashi or Nomura references, nor by the Windows 95 Paint Program. This Windows reference may refer to painting a boundary line with a brush, but it does not disclose nor suggest changing a color of only the colored line when the pointing device is moved from a region to another region

across the colored line. Accordingly, claim 13, as presented, which includes the features of canceled claim 78 is allowable, as are dependent claims 79 and 80.

With respect to paragraph twenty-six (26), claims 84 to 86 were rejected under 35 U.S.C. § 103(a) as obvious over Hayashi, U.S. Patent No. 5,611,037, in view of Nomura et al., U.S. Patent No. 5,877,772, and further in view of the Windows 95 Paint Program.

As explained above, claim 84 has been canceled since its features have been included in claim 37 as presented, and claim 85 now depends from claim 37, as does claim 86.

The “claim 84” feature is not disclosed nor suggested by the Hayashi or Nomura references, nor by the Windows 95 Paint Program. This Windows reference may refer to painting a boundary line with a brush, but it does not disclose nor suggest changing a color of only the colored line when the pointing device is moved from a region to another region across the colored line. Accordingly, claim 37, as presented, which includes the features of canceled claim 84 is allowable, as are dependent claims 85 and 86.

With respect to paragraph twenty-eight (28), claims 90 to 92 were rejected under 35 U.S.C. § 103(a) as obvious over Hayashi, U.S. Patent No. 5,611,037, in view of Nomura et al., U.S. Patent No. 5,877,772, and further in view of the Windows 95 Paint Program.

As explained above, claim 90 has been canceled since its features have been included in claim 59 as presented, and claim 91 now depends from claim 59, as does claim 92.

The “claim 90” feature is not disclosed nor suggested by the Hayashi or Nomura references, nor by the Windows 95 Paint Program. This Windows reference may refer to painting a boundary line with a brush, but it does not disclose nor suggest changing a color of only the colored line when the pointing device is moved from a region to another region across the colored line. Accordingly, claim 59, as presented, which includes the features of canceled claim 90 is allowable, as are dependent claims 91 and 92..

As further regards all of the above obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and there must be a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). It is respectfully submitted that the references relied upon simply do not address the problems

(referred to in the present application) that are met by the address filter subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action's assertions that it would have been obvious to modify or combine the references relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" — which is not even the case here, there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed", stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). As referred to above, any review of the reference relied upon makes plain that it simply does not describe the features discussed above of the rejected claims.

In summary, it is respectfully submitted that all of claims 13, 15, 17, 37, 39, 41, 59, 61, 63, 79 to 83, 85 to 89 and 91 to 95, as presented, of the present application are allowable at least for the foregoing reasons.

CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claims 13, 15, 17, 37, 39, 41, 59, 61, 63, 79 to 83, 85 to 89 and 91 to 95, as presented, are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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